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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,422	10/16/2002	Robert Michael Vavrek	125477	6750

23413 7590 09/08/2003

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EXAMINER
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ARANA, LOUIS M

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/065,422

Applicant(s)

VAVREK ET AL.

Examiner

Louis M. Arana

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 8-17 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-7 and 8-22) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that "there is no burden on the examiner" and that distinctness between the process and apparatus has not been shown. This is not found persuasive because to thoroughly search and examine both inventions in the very limited time allotted the examiner for the examination of this application the examiner would need to extend the search to e.g. Class 600 which also examines MRI methods that more closely pertain to patient, as is the case in this application that is drawn to nerve stimulation. The examiner disagrees with applicant that there is no burden. If there were no burden why would the examiner spend time and effort in writing and justifying a restriction requirement if it were easier to search and examine multiple inventions ?. As to distinctness, applicant's arguments are completely unconvincing, while on the one hand applicant acknowledges a "distinction", on the other hand contends that the distinction approaches employing the invention in an unreasonable manner. The examiner cannot presume from what is claimed e.g. a gradient coil structure, that using a method that prevents nerve stimulation, constitutes somehow, the "most efficient imaging methodology". The examiner submits that most practitioners of the art would disagree with such contention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-17 and 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable

Art Unit: 2859

generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimmlingen et al. P.N. 6,418,336 (Kimmlingen) in view of Katznelson et al. P.N. 5,736,858 (Katznelson).

Kimmlingen discloses a multiple portion coil system for MRI. Applicant's attention is directed to the description of Fig. 1 and claim 1 of the Kimmlingen disclosure. The multiple portion coil allows for imaging in a plurality of fields of view as most simply described in the abstract of the disclosure. Note that the multiple portion coil is a Z-gradient coil.

Art Unit: 2859

The only difference between Kimmlingen and the claims at issue is that Kimmlingen does not specifically show or explicitly describe the other two gradient coils, that is the X-gradient and Y-gradient coils.

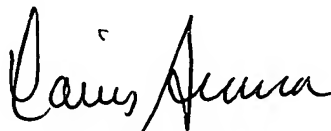
The inclusion of such coils in a system such as Kimmlingen, would have been obvious to the artisan of ordinary skill in the art. It is well known that for MRI three sets of orthogonal gradients would be needed. See for example lines 25-45 of col. 1 of Katznelson.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kimmlingen '977 Gebhardt et al. and DeMeester et al. all disclose variable FOV gradient coil systems. Note the abstract of each disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis M. Arana whose telephone number is (703) 305-4913. The examiner can normally be reached on M-Thurs. Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.



Louis M. Arana  
Primary Examiner  
Art Unit 2859